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Hearing:
June 25, 2002

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THE TTAB

Paper No. 13
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lee Fashion Fabrics, Inc.

Serial No. 75/566,627

Irwin C. Alter of Alter and Weiss for Lee Fashion Fabrics,
Inc.

Jane C. Kang, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Seeherman, Hanak and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Lee Fashion Fabrics, Inc. sought to register the term STARSUEDE on the Principal Register in conjunction with services recited, as amended, as "wholesale distributorship for suede-like synthetic fabric in the piece used for apparel, upholstery and seating material on office and residential furniture; inserts and covers on wood furniture; coverings for walls, ceilings and panels; and footwear, bags, portfolios and other personal accessories and other special end users," in International Class 35.¹

¹ Application Serial No. 75/566,627 was filed on October 7, 1998 based upon applicant's allegation of use in commerce since at least

The Trademark Examining Attorney has finally refused registration on the ground that none of the various specimens submitted by applicant show use of the mark in connection with these services.

Applicant has appealed the final refusal to register. Applicant and the Trademark Examining Attorney have fully briefed the case. At applicant's request, a hearing was heard before the Board on June 25, 2002.

We affirm the refusal to register.

The original specimens received with the application were copies of sample swatches of fabric, color cards and performance test results, as well as two pages of promotional materials, including a photocopy of the front cover of a brochure entitled "The Starsuede Star Guide 1990." In its response of February 15, 2001, applicant submitted the aforementioned Starsuede brochure of 1990 in its entirety. While the Trademark Examining Attorney, in her final Office action, provided applicant the opportunity to submit yet

as early as 1977. Applicant's recitation of services was amended voluntarily by applicant in its June 12, 2001 response to an earlier Office Action.

Additionally, during the prosecution of this application, applicant claimed ownership, by assignment, of Reg. No. 1,839,463, also for the mark STARSUEDE, for "suede-like synthetic fabric in the piece used for upholstery and seating material on office and residential furniture, inserts and covers on wood furniture; coverings for walls, ceilings and panels; and footwear, bags, portfolios and other personal accessories," in International Class 24.

further sets of substitute specimens supporting usage in connection with the identified services, applicant chose to rely upon those previously submitted. In denying applicant's request for reconsideration, the Trademark Examining Attorney continued to charge that none of the specimens of record shows use of the mark in connection with applicant's offering the claimed distributorship services to potential customers.

Section 1(a)(1) of the Trademark Act, 15 U.S.C. §1051(a)(1), requires that applicant furnish specimens of the mark as used. The function of a service mark is "to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services" A mark is deemed to be in use on services "... when it is used or displayed in the sale or advertising of services and the services are rendered in commerce... ." See Section 45 of the Trademark Act, 15 U.S.C. §1127.

Because service marks can be used in a great number of ways, the types of specimens that demonstrate the use of service mark are numerous. However, there must be some direct association or nexus between the offer of services and the mark sought to be registered. Hence, applicant must furnish specimens or facsimiles showing use of the mark in connection

with the offering of the recited services. See also Trademark Rule 2.58, 37 C.F.R. §2.58.

As correctly argued by the Trademark Examining Attorney:

Whether a mark has been used for a particular service is a question of fact to be determined primarily on the basis of the specimens. In re Advertising and Marketing Development Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987) (sets out "direct association test" between the mark sought to be registered and the services specified in the application; cases involving advertising services may present factual considerations including whether the services are "sufficiently separate" from the subject of the advertising, and whether the mark has been used to identify the advertising services themselves); In re Duratech Industries Inc., 13 USPQ2d 2052 (TTAB 1989) (the mere fact that the bumper stickers are distributed by organizations which perform the services did not persuade the Board that members of the general public who encounter the services would perceive the design on the bumper stickers as a mark identifying the services); In re Moody's Investors Service Inc., 13 USPQ2d 2043 (TTAB 1989) ("Aaa" as used on the specimens, found to identify the applicant's ratings instead of its rating services); In re El Torito Restaurant Inc., 9 USPQ2d 2002 (TTAB 1988) (no evidence of use of MACHO COMBOS for restaurant services where specimens showed use only to identify food items);² Peopleware Systems, Inc. v. Peopleware, Inc., 226

² Although the instant applicant argues that El Torito supports its position, we disagree. The specimens of use in El Torito were table tents in the restaurant depicting plates of food with the wording "INTRODUCING OUR FIVE MACHO COMBOS." That applicant sought to register the mark MACHO COMBOS for "multiple combinations of plates of food items as part of restaurant services." However, we held that the term was being used only in reference to the food items - not as a service mark for the restaurant services. See also In re Brown & Portillo, Inc., 5 USPQ2d 1391 (TTAB 1987) {"it does not logically follow that any arbitrary designation used in a menu to identify a particular food or beverage available in that restaurant also necessarily performs a service mark function to identify the restaurant services."}.

USPQ 320, 323 (TTAB 1985) (it is insufficient that a term alleged to constitute the mark be used in advertising, there must also be a direct association between the term and the services with respect to the advertising; use of the term PEOPLEWARE merely within a byline on calling card specimen did not constitute service mark usage of term, even though specimens elsewhere evidenced that applicant provides the recited services); In re Hughes Aircraft Co., 222 USPQ 263 (TTAB 1984) (specimens and other material offered by the applicant showed mark used only in connection with a photochemical process or method, with no association between the applicant's offer of services and the mark); see also Ready Communications v. Environmental Action Foundation, 477 F. Supp. 936, 203 USPQ 144 (D.D.C. 1979) (the mere advertising of one's goods does not constitute service mark; use of the mark in technical bulletins and data sheets merely identified and advertised chemicals and not services).

(Trademark Examining Attorney's appeal brief, pp. 4-5).

Accordingly, to determine whether applicant's alleged service mark has been used in connection with the recited services, we take a closer look at the specimens of record. The manner of use on the specimens must be such that potential purchasers would readily perceive the subject matter as identifying and distinguishing the applicant's services and indicating their source, even if that source is unknown. Section 45 of the Trademark Act, 15 U.S.C. §1127, TMEP § 1301.04.

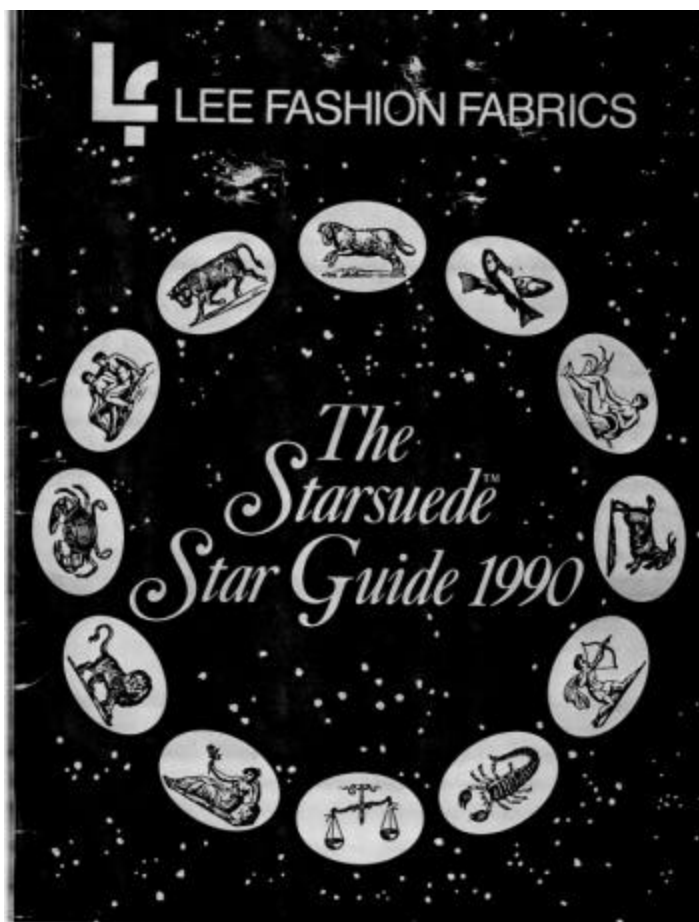
In analyzing factually the acceptability of specimens of use, we have held that "while the nature of the services does not need to be specified in the specimens, there must be

something which creates in the mind of the purchaser an association between the mark and the service activity." See In re Johnson Controls, Inc., 33 USPQ2d 1318 (TTAB 1994), citing to Intermed Communications Inc. v. Chaney, 191 USPQ 501 (TTAB 1977) and In re Metriplex, Inc. 23 USPQ2d 1315 (TTAB 1992). It is the absence of any association or nexus between the mark and the services that supports the position taken by the Trademark Examining Attorney herein.

The photocopied pages submitted with the original application merely provide information about the STARSUEDE line of synthetic fabrics and its uses. These include product specifications, descriptions of the goods, as well as features of the quality and nature of the goods. It is abundantly clear that Lee Fashion Fabrics (applicant) offers for sale a line of synthetic, suede-like fabrics which it calls STARSUEDE, and that it markets these fabrics directly to its customers at prices characterized as "factory direct." Consistent with the extant federal trademark registration owned by applicant, it appears from these pages that STARSUEDE serves as a source indicator for applicant's fabrics, but the specimen does not show use of the mark for distribution services.

We turn next to the advertising brochure submitted as a substitute specimen ("The Starsuede Star Guide 1990"). The

star motif is dominant throughout the brochure: the cover having the twelve signs of the Zodiac, each individual page having a different sign of the Zodiac and a corresponding star-shaped swatch of fabric, and frequent examples of text playing on this motif.



Upon close examination of the text of this replacement specimen of use, we see wording that identifies the goods as

- "the polyester with real star quality"
- "today's most seductive sensation in fashion is available in a stellar array of colors, as you'll

see from our color book forecast. We offer plain, printed and embossed designs"

- "This year, all signs point to STARSUEDE™ of Golden Touch polyester, from Lee"
- "STARSUEDE™ -- the preferred suede"
- "STARSUEDE™ [is] from Lee Fashion Fabrics"

Applicant contends that "Lee Fashions offers wholesale consumers fabric products and services to distribute such products, the same mark is used to identify both the fabric product and the related distribution service." Certainly, applicant is correct in arguing that a manufacturer or merchant may use a single source indicator as both a service mark and a trademark. Furthermore, it is quite logical that applicant's ultimate objective is to distribute the goods that it manufactures.

Applicant argues strenuously that its targeted customers would perceive the term STARSUEDE, as shown in the pages of this brochure, to be a source indicator for the recited services. We disagree. Nowhere do the specimens of use show STARSUEDE being used as a service mark. There is no language at all in the specimens that makes either a direct or an indirect association between the mark, STARSUEDE, and applicant's distributorship services.

Accordingly, in the absence of a nexus between STARSUEDE and the recited services, we affirm the refusal of the Trademark Examining Attorney as to registration of this mark for distributorship services.

Decision: The refusal to register is affirmed on the ground that the specimens of record are not acceptable evidence of actual service mark usage of the mark STARSUEDE.